

### **REMARKS**

Claims 1-14 and 19-33 are pending in the application. Claims 2-4, 6-14, and 19-33 have been amended to clarify the claims' scopes. These amendments are not narrowing, and do not introduce any new matter. In view of the following considerations, claims 1-14 and 19-33 are believed to be allowable.

#### **I. CLAIM OBJECTIONS**

Claims 1, 9, 10, 19, 24, 27, and 28 were objected to because each recited a limitation such as "second data elements" without first reciting "first data elements."

To make the claim limitations sequential as requested, the following claim amendments have been made:

the term "output data" has replaced the term "sixth data";

the term "counter data" has replaced the term "seventh data";

the term "slicer data" has replaced the term "eighth data";

the term "first sign indicating data" has replaced the term "tenth data";

the term "second sign indicating data" has replaced the term "eleventh data"; and

the term "count data" has replaced the term "thirteenth data".

These amendments do not limit the scope of the claims in any way, nor do they introduce new matter.

Further regarding claim 10, the term "gain control component" has been substituted for the term "second gain control" as suggested. Also the term "AGC means" has been substituted for the term "second AGC means." This amendment does not limit the scope of the claim in any way, nor does it introduce new matter.

Claims 19 and 24 have been amended to correct a typographical error in the previous claim sets. Namely, the term "data" has been substituted for the term "date". These amendments do not limit the scope of the claims in any way, nor do they introduce new matter.

**II. REJECTION OF CLAIMS 1 AND 5 UNDER 35 U.S.C. § 103(a).**

**A. U.S. Patent No. 6,577,196 (Hart)**

Pending claims 1 and 5 were rejected under 35 U.S.C. § 103(a) in view of the admitted prior art and U.S. Patent No. 6,577,196 (Hart). Withdrawal of this rejection is respectfully requested for at least the following reasons.

**i. *With respect to the current application, Hart is not available prior art under 35 U.S.C. § 103(a).***

35 U.S.C. § 103(c) provides clarification as to which references may be considered in determining non-obviousness. Section 103(c) states as follows:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

**ii. *The current Application (Application No. 10/057,502) is assigned to Infineon Technologies NA, and U.S. Patent 6,577,196 (Hart), at the time the invention of Application 10/057,502 was made, owned by Infineon Technologies AG. Since Infineon Technologies NA is a wholly owned subsidiary of Infineon Technologies AG, both are owned by the same person under Section 103(c).***

Therefore, so long as Hart qualifies as prior art only under one or more of sections (e), (f) and (g) of section 102, Hart must be disqualified as a reference under section 103. See MPEP § 706.01(I)(1).

As now set forth, Hart is available as prior art only under section 102(e), and therefore is not available for at least the following reasons.

First, Hart cannot be considered prior art under § 102(b). A reference qualifies as prior art under 102(b), only if the publication date or issue date is more than 1 year prior to the effective filing date of the application. 35 U.S.C. § 102(b). See *also* MPEP

§ 706.02(a). Hart has a publication date of 8/22/02 and an issue date of 6/10/03. Neither date is more than one year prior to the current application's filing date of 1/25/02.

Secondly, Hart cannot be considered prior art under § 102(a). A reference qualifies as prior under § 102(a) if it was issued or published prior to the effective filing date of the application. 35 U.S.C. § 102(a). See *also* MPEP § 706.02(a). Both Hart's publication date (8/22/02) and issue date (6/10/03) are after the current application's filing date (1/25/02), and thus neither qualifies as § 102(a) art.

Because Hart did not issue as a foreign patent prior to the current application's filing (indeed, the German priority document was not even published until 3/28/02), Hart is not prior art under § 102(d). Nonetheless, because the inventive entity of the Hart reference differs from that of the current application, the Hart U.S. publication does qualify as § 102(e) prior art as of its earliest U.S. filing date (notably, for purposes of § 102(e), foreign priority claims under § 119(a)-(d) are not considered in determining the earliest U.S. filing date; thus, for § 102(e) purposes, the earliest U.S. filing date is 8/30/01). Therefore, Hart qualifies as prior art only under § 102(e), notwithstanding an analysis of sections 102(f) and 102(g).

Therefore, accordance with the provisions of § 103(c), Hart must be disqualified as a reference. Because Hart is not available, the remaining prior art of record fails to disclose various elements of claim 1, including at least: a first AGC for determining a number of second data elements generated per unit of time having values within a first range and for adjusting the first gain when the determined number falls outside a second range. Accordingly, withdrawal of the rejection of claim 1 is respectfully requested.

As the rejection of claim 5 also relies on Hart, which must now be disqualified, the prior art of record also fails to disclose its elements. Accordingly, withdrawal of the rejection of claim 5 is also respectfully requested.

*B. U.S. Patent No. 6,870,891 (Wu)*

Pending claims 2-4 were rejected under 35 U.S.C. § 103(a) over the admitted prior art in view of U.S. Patent No. 6,577,196 (Hart) and further in view of U.S. Patent No. 6,870,891 (Wu). Withdrawal of this rejection is respectfully requested for at least the following reasons.

***Wu fails to cure the deficiencies of the admitted prior art.***

Applicants have shown that the Hart reference must be disqualified and reiterate those arguments from above. The admitted prior art, by itself, does not teach the limitations of claims 2-4 and Wu fails to cure these deficiencies. Therefore, neither the admitted prior art nor Wu teaches claims 2-4, either alone or in combination.

**IV. CONCLUSION**

For at least the above reasons, pending claims currently under consideration are believed to be in condition for allowance and notice thereof is requested.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

In addition, should any fees be due as a result of the filing of this response, the Commissioner is hereby authorized to charge the Deposit Account Number 50-1733, INFNP118US.

Respectfully submitted,  
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CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: March 10, 2006

  
Christine Gillroy